

03500.008672.2

PATENT APPLICATION

AUG 10 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
MASAKI OKADA ) Examiner: R. Chevalier  
Application No.: 09/283,285 ) Group Art Unit: 2615  
Filed: April 1, 1999 )  
For: RECORDING APPARATUS )  
AND REPRODUCTION APPARATUS )

August 10, 2004

Office of Petitions  
Commissioner for Patents  
Washington, D.C. 20231

PETITION UNDER 37 C.F.R. § 1.182  
AND AMENDMENT

Sir:

Petitioner hereby petitions the Commissioner under 37 C.F.R. § 1.182 to amend the abandoned parent of the present continued prosecution application to include domestic priority information as set forth below. The Commissioner is authorized to charge the \$130.00 petition fee set forth in 37 C.F.R. § 1.17(h) to Deposit Account No. 06-1205.

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## FACTS

(1) The present continued prosecution application has the following lineage:

(i) This application is a continued prosecution application filed under 37 C.F.R. § 1.53(d) on May 1, 2002 (hereinafter “the CPA application”).

(ii) The CPA application is a continued prosecution application of Application No. 09/283,285, April 1, 1999 (hereinafter “the original ‘285 application”).

(iii) The original ‘285 application is a continuation of Application No. 08/320,833 filed October 7, 1994, which issued as US Patent No.

5,903,703 on May 11, 1999 (hereinafter “the ‘833 parent application”).

(iv) The ‘833 parent application is a continuation of Application No.

07/935,908 filed August 27, 1992, which was abandoned (hereinafter “the ‘908 grandparent application”).

(2) Filing of the CPA application effected an abandonment of the original ‘285 application pursuant to 37 C.F.R. § 1.53(d)(2)(v), which states that the CPA application “is a request to expressly abandon the [original ‘367 application] . . . .”

(3) 35 U.S.C. § 120 states that an application that seeks to claim the benefit of a filing date of a previously filed application must contain “a specific reference to the earlier filed application.” The original ‘285 application was not amended to include specific references to both the ‘833 parent application and the ‘908 grandparent applications before it was abandoned.

(5) Pursuant to operation of 37 C.F.R. § 1.53(d)(7), the CPA application itself need not be amended to include references to its immediate parent (here, the original '285 application) since a request for the CPA "is the specific reference required by 35 U.S.C. 120 . . ."

(6) Since the specification of the original '285 application was not amended to include specific references to both the '833 parent application and the '908 grandparent application, the status of the domestic priority chain of the CPA application is in question.

#### ARGUMENT

(7) Petitioners are not seeking to amend the CPA application. Rather, Petitioners are seeking to amend the original '285 application, which was abandoned in favor of the CPA application, to include specific references to both the '833 parent application and the '908 grandparent application.

(8) Courts have granted permission to amend the specification of previously filed applications that are now abandoned in order to perfect a chain of priority under 35 U.S.C. § 120. See *Sampson v. Commissioner of Patents*, 195 U.S.P.Q. 136 (D.D.C. 1976). In *Sampson*, a patentee was granted permission to amend the specification of an abandoned parent application to perfect a priority chain while seeking re-issuance of a patent. See, also, <http://www.USPTO.gov/web/offices/dcom/olia/aipa/infoexch.htm>, which cites this case approvingly for these circumstances.

(9) Wherefore, granting of this petition and entry of the following amendment are respectfully requested.